

REMARKS

Claims 1-10 are currently pending in the subject application and are presently under consideration. Thus, after entry of these amendments, claims 1-20 will be pending in the application.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-10 Under 35 U.S.C. §102(b)

Claims 1-10 stand rejected under 35 U.S.C. §102(b) as being anticipated by Lioy WO 00/76173 A1.

Applicant respectfully traverses this rejection as the cited reference does not disclose each and every element recited by the claims. For a prior art reference to anticipate, 35 U.S.C. §102 requires that

each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹

Further:

To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’²

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.³

Claims 1-9 recite that a negative acknowledgement message “includes deliberately arbitrary supplemental IPCP information and does not include an IP address

¹ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999)(quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, USPQ2d 1051, 1053 (Fed. Cir. 1987)).

² *Id.* (quoting *Continental Can co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)).

³ *Mehl/Biophile Int'l Corp. v. Milgram*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999), reh'g denied, 1999 U.S. App. LEXIS 31386 (Fed. Cir. Oct. 27, 1999) (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

option.” Also, claim 10 recites “triggering the PPP client to generate configuration request messages that include deliberately arbitrary supplemental IPCP information and that do not include an IP address option.” The Examiner contends that the disclosure of “hint values” at page 10, lines 29-31 anticipates the recited subject matter. In particular, at page 10, lines 30-31, the cited reference discloses “a Configure-Nak comprising hint values.” Applicant respectfully disagrees with this conclusion.

In a departure from the claimed subject matter, the cited reference does not specifically disclose the negative acknowledgement message (claims 1-9) or the configuration request message (claim 10) having “deliberately arbitrary supplemental IPCP information,” but instead discloses “hint values.” It is not clear as to how these “hint values” are exactly identical to the recited “deliberately arbitrary supplemental IPCP information.” In particular, claims 4 and 5 further recite that the “arbitrary supplemental IPCP information” respectively comprises an “arbitrary DNS address” or an “arbitrary WINS address.” With regard to claims 4 and 5, the Examiner repeats the same vague rejection pointing to the “hint values” disclosed by the cited reference, without any explanation as to how the “hint values” disclose the recited subject matter, but instead focusing on the result. As noted below, this is insufficient grounds for anticipating the recited subject matter. Additionally, the cited reference does not specifically disclose that the negative acknowledgement message (claims 1-9) or the configuration request message (claim 10) is generated “not includ[ing] an IP address option,” as specifically recited by the present claims. Furthermore, the cited reference does not specifically disclose that the negative acknowledgement message (claims 1-9) or the configuration request message (claim 10) includes the combination of “deliberately arbitrary supplemental IPCP information and does not include an IP address option,” as recited by the present claims. Thus, the cited reference does not expressly disclose “each and every element as set forth in the claim[s],” as required by the statute.

Further, the Examiner has not provided the required “extrinsic evidence [that] ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’” The Examiner is reminded that the “mere fact that a certain thing may result from a given set of circumstances is not sufficient” to establish inherency. In particular,

with regard to claims 1-5, the Examiner draws elaborations with respect to the meaning of "hint values," however, the Examiner has not provided any factual basis supporting these elaborations.⁴

Therefore, based on the above remarks, the cited reference does not disclose each and every element recited by the claims. Thus, Applicant requests that the Examiner withdraw this rejection.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 17-0026.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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⁴ See, e.g., Office Action, page 3, lines 6-9, page 3, line 19 to page 4, line 2, page 4 at lines 8-10, 13-16, and page 4, line 19 to page 5, line 3.